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which a control value for processing the plurality of image data in an image reproduction apparatus is generated; and

recording a designating data including information which of a plurality of image data is the standard image data.

## REMARKS

Claims 3, 4, 7, 58-61 and 69-76 are pending in this application. Applicants acknowledge the Examiner's indication in the Office Action that claims 3, 4 and 7 are allowable over the prior art of record. Claims 58, 61, 69 and 72 have been amended. Attached hereto is a marked-up version of the changes made to the claims by this Amendment. The marked-up version has been entitled "Attachment A – Marked-Up Version of Amended Claims."

The Examiner has rejected applicants' claims 61, 71, 74 and 76 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 74 and 76 were specifically rejected as depending from the indefinite independent claims.

Applicants note that while the Examiner has rejected claim 71, it is evident that his rejection on these grounds is directed to claim 72, from which claim 76 depends. Applicants discussion of this rejection is therefore directed to claims 61, 72, 74 and 76. The rejection is respectfully traversed and reconsideration is requested.

Claims 61 and 72 have been amended to overcome this rejection and now clearly describe the "image data" as standard image data and that a control value for processing the plurality of image data in an image reproduction apparatus is generated based on the standard image data. Applicants therefore submit that independent claims 61 and 72, as amended, and





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their respective dependent claims 74 and 76, particularly point out and distinctly claim applicants' invention in compliance with the provisions of 35 USC § 112, second paragraph.

The Examiner has rejected applicants' claims 58-60 and 69-71 under 35 USC § 102(e) as anticipated by Saito patent (U.S. Patent No. 5,153,729). The Examiner has further rejected applicants' claims 73 and 75 under 35 USC § 103(a) as unpatentable based on the Saito patent taken in view of Suzuki et al. patent (U.S. Patent No. 5,283,632). Finally, the Examiner has rejected applicants' claims 61, 72, 74 and 76 under 35 USC §103(a) as unpatentable over the Suzuki et al. patent taken in view of the Saito patent. With respect to applicants' claims, as amended, these rejections are respectfully traversed.

Applicants' independent claims 58, 61, 69 and 72 have been amended to better define applicants' invention. Claims 58 and 69 now recite an apparatus and method for reproducing an image data stored in a detachable recording medium recording a plurality of image data together with a designation data that indicates which of a plurality of image data is standard image data. More particularly, these claims additionally now recite that the standard image data of the plurality of image data, which is indicated by designation data recorded on the recording medium, is an image of a white object. A control value is generated on the basis of the standard image data and is used to process the plurality of image data.

Amended claims 61 and 72 recite an apparatus and method for picking up images and recording a plurality of image data on a detachable recording medium. The method and apparatus are additionally recited as designating an image data, which is an image of a white object, from the plurality of image data, to be recorded on the recording medium as a standard image data. A control value for processing the plurality of image data in an image reproduction apparatus is generated based on the standard image data, and the designated data that indicates which of a plurality of image data is the standard image data is then recorded.

Such constructions are neither taught nor suggested by the cited Saito and Suzuki et al. patents. With respect to claims 58 and 69, the Examiner has argued (citing column 4, lines 37-51 of the Saito patent) that the Saito patent teaches "a playback apparatus [that] plays back image data (i.e., image data being standard image data of a plurality of image data) loaded on the detachable memory cartridge based on a picture quality mode (i.e., designation data))." The Examiner has further argued (citing column 4, lines 45-51, and column 5, lines 44-50) that the Saito patent teaches "processing the plurality of image data by using the control value (... the playback apparatus checks the picture quality mode so as to determine a data expansion system suitable for the picture quality mode (the data expansion is a control value used for processing the plurality of image data)."

In the Saito patent, therefore, the picture quality mode (designation data) is used to indicate to the playback apparatus the data expansion mode to be used with the image data for the picture quality mode. The patent fails to teach or suggest that the designation data is used to indicate which of a plurality of image data is standard image data, or that such standard image data is an image of a white object, or that the standard image data is used to generate a control value for processing the plurality of image data. It is therefore submitted that the independent claims 58 and 69, which recite these features, patentably distinguish over the cited Saito patent.

Moreover, with respect to claims 61 and 72, the Examiner has argued (citing column 4, lines 40-45 and 55-63 and column 26, lines 38-46 of the Suzuki et al. patent) that the Suzuki reference teaches "generating a control signal for white balance adjustment by using a signal output from an image pickup element," "recording a designating data for selecting the image data" and a "memory storing white balance control voltages." The Examiner argued that it

would have been obvious to combine a detachable memory as taught by the Saito patent with the device of Suzuki et al patent.

The portions of the Suzuki et al. patent cited by the Examiner in fact teach first and second white balance adjusting means that generate control signals for white balance adjustment using signals output from an image pickup element and from a color measure sensor, respectively, and performing white balance adjustment using control values stored in a memory. The Suzuki et al. patent fails to teach or suggest that designation data is used to indicate which of a plurality of image data is recorded as standard image data, or that such standard image data is an image of a white object, or that the standard image data is used to generate a control value for processing the plurality of image data in an image reproduction apparatus. It is therefore submitted that the independent claims 61 and 72 patentably distinguish over the Suzuki et al. patent cited by the Examiner. Additionally, the Saito patent, as discussed above, also fails to teach or suggest these features.

Accordingly, applicants respectfully submit that the Saito patent does not disclose the features of the claimed imaging apparatus, either alone or in combination with the Suzuki et al. patent cited by the Examiner, and thus the patents do not teach or suggest the invention as claimed in the amended claims within the meaning of Sections 102 and 103. Reconsideration of the claims is respectfully requested.

Reliance is placed on In re Fine, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988) and Ex parte Kochan, 131 U.S.P.Q. 204 (Bd. App. 1960) for allowance of the dependent claims, since they differ in scope from the parent independent claims which are submitted as patentable.

Applicants have filed concurrently herewith a Request for a Telephone Interview to discuss the subject Amendment and the pending claims in the event there are still any patentability issues remaining after the Examiner considers this Amendment.

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Respectfully submitted,

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Attachment A – Marked-Up Version of Amended Claims

IN THE CLAIMS

Amend claims 58, 61, 69 and 72 as follows:

-- 58. (Three Times Amended) An image reproduction apparatus for reproducing an image data stored in a detachable recording medium recording a plurality of image data together with a designation data [which selects an image data as a] that indicates which of a plurality of image data is standard image data, comprising:

a control device adapted to select [an image data] as the standard image data which is an image of a white object of the plurality of image data, on the basis of the designation data recorded on said recording medium, and

an image processing device adapted to generate a control value, on the basis of said standard image data, and process the plurality of image data by using the control value. --.

-- 61. (Three Times Amended) An image pickup apparatus for [photographing] picking up images of objects to record a plurality of image data on a detachable recording medium, comprising:

a designating device [for designating] adapted to designate an image data, which is an image of a white object, of the plurality of image data, to be recorded on said recording medium, as a standard image data on the basis of which a control value for processing the plurality of image data in an image reproduction apparatus is generated; and

a designated image data recording device [for recording] adapted to record a designating data [for selecting the image data] that indicates which of a plurality of image data is the standard image data. --.

-- 69. (Three Times Amended) A method of image reproduction for reproducing an image data stored in a detachable recording medium recording a plurality of image data together

with a designation data [which selects an image data as a] that indicates which of a plurality of image data is standard image data, comprising:

selecting said image data as said standard image data, which is an image of a white object, of the plurality of image data on the basis of the designation data recorded on said recording medium;

generating a control value for processing the plurality of image data, on the basis of said standard image data; and

processing the plurality of image data by using the control value. —.

— 72. (Three Times Amended) A method for [photographing an object to record] recording a plurality of picked up image data on a detachable recording medium, comprising:

designating an image data of the plurality of the image data, to be recorded on said recording medium, as a standard image data, which is an image of a white object, on the basis of which a control value for processing the plurality of image data in an image reproduction apparatus is generated; and

recording a designating data including information [about selecting the standard image data of the plurality of image data] which of a plurality of image data is the standard image data.

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